Remarks/Arguments

Reconsideration of the captioned application as amended herewith and in view of the following Remarks and Arguments is respectfully requested.

Upon entry of this Amendment, Claims 1 - 13 will be pending in the application.

Claims 8, 9, and 13 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for containing terms that were not defined. Claims 8, 9, and 13 have been amended to delete the terms "derivative" and "protect". Applicants respectfully submit that the rejections under 35 U.S.C. 112 have been obviated. Therefore, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 112.

Claims 1 – 3, 10 and 11 were rejected under 35 U.S.C. 102 (b) as being anticipated by United States Patent No. 4,000,317 to Menda et al. ("'317"). Claims 1 – 4, 8 and 11 were rejected under 35 U.S.C. 102 (b) as being anticipated by United States Patent No. 4,362,715 to Strianse et al. ("'715"). Claims 1 - 10, 12 and 13 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Neova product label ("Neova") in view of United States Patent No. 5,139,771 to Gerstein ("'771"). Claim 11 was rejected under 35 U.S.C. 103 (a) as being unpatentable over Neova in view of '771, and further in view of Cabot Technical Data ("Cabot"). Claims 1 – 4 and 11 – 13 were rejected under 35 U.S.C. 103 (a) as being unpatentable over United States Patent No. 5,139,782 to Jung ("'782").

Amendments To The Claims

Claims 1, 8, 9, and 13 have been amended to better define the present invention. Support for these amendments comes from page 3, lines 31 – 33 and the preamble of claim1 of the specification as originally filed.

The Rejections under 35 U.S.C. §102 (b) Have Been Overcome

Claims 1 – 3, 10 and 11 were rejected under 35 U.S.C. 102 (b) as being anticipated by the '317 patent. Claims 1 – 4, 8 and 11 were rejected under 35 U.S.C. 102 (b) as being anticipated by the '715 patent. Rejections under 35 USC §102 are proper only when the claimed subject matter is identically

disclosed or described in the prior art. In re Marshall, 198 USPQ 344 (CCPA 1978). In other words, to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art. Id.

Applicants respectfully submit that the references cited by the Examiner do not teach a facial mask composition having from about 5 to about 40 percent by weight of the total composition silica. Furthermore, neither '317 nor '715 teaches a facial mask composition that changes color upon drying. Therefore, because the references do not teach all of the material elements recited in the present claims, Applicants respectfully submit that the rejections under 35 U.S.C. 102 (b) have been overcome. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 102 (b).

Th Rejections under 35 U.S.C. §103 (a) Have Been Overcome

Claims 1 - 10, 12 and 13 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Neova in view of the '771 patent. Claim 11 was rejected under 35 U.S.C. 103 (a) as being unpatentable over Neova in view of the '771 patent, and further in view of Cabot. Claims 1 – 4 and 11 – 13 were rejected under 35 U.S.C. 103 (a) as being unpatentable over the '782 patent. Applicants respectfully traverse these rejections.

The Examiner relies upon the Neova product label as disclosing a silica-containing skin mask composition. Recognizing that Neova fails to teach the incorporation of a colorant or the quantity of surfactants used, the Examiner relies upon the '771 patent. For the reasons discussed below, the '771 patent fails to remedy the deficiencies of Neova.

As discussed in the Specification, it is sometimes difficult to determine when it is time to remove a dry facial mask. The mask should be left on long enough to provide the cleansing, exfoliating, and moisturizing properties it is meant to deliver. Facial mask formulations are typically prepared such that the proper leave on time for the desired benefits is equal to the drying time of the formulation. Therefore, typical facial masks should be removed when the formulation has completely dried. However, with many facial mask formulations, it is difficult to tell when the formulation has completely dried. Therefore, there is a need for a facial mask that provides a change in appearance that indicates it is dry. The present invention answers this need.

Claim 1 relates to a composition for forming a cosmetic mask comprising at least one colorant and from about 5 to about 40 percent by weight of the total composition silica, wherein when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color

change in the composition when the composition dries. Such a facial mask is neither taught nor suggested by the combination of Neova and the '771 patent.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Here, there is nothing in the teachings of Neova and the '771 patent that would provide one of ordinary skill in the art with the suggestion or motivation to incorporate a colorant into the Neova compositions in order to obtain a facial mask composition that changes color when the composition is dry. The Examiner recognizes that the combined references "do not explicitly provide that the color changes as the composition dries." Nevertheless, the Examiner has taken the position that "the color change is an inherent property of the prior art composition which otherwise meets the limitation of the instant claims." Applicants respectfully traverse.

The Examiner has not provided any rational or evidence which tends to show inherency. See M.P.E.P. § 2112, p. 2100-51. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *Id.*

There is nothing in the Neova product label that would suggest to one of ordinary skill in the art that silica could be used in combination with a colorant to provide an indication that the composition has dried via a color change in the composition. In fact, as recognized by the Examiner the Neova product label does not even mention the use of colorants. Further, the '771 patent simply teaches that colorants can be added to "impart a pleasant color to the face masque composition." See col. 5, lines 28-32. Accordingly, the '771 patent fails to remedy the deficiencies of the Neova product label.

Even if one of ordinary skill in the art were motivated to incorporate a colorant into the composition disclosed by the Neova product label, a cosmetic mask composition comprising at least one colorant and from about 5 to about 40 percent silica, wherein when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color change in the composition when the composition dries would not necessarily result since neither Neova nor the '771 patent teach or suggest a facial mask composition that changes color upon drying. As discussed in the M.P.E.P., the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency of that result. Accordingly, Applicants respectfully submit that applicants claimed invention is not inherent in or

obvious over the combination of the Neova product label and the '771 patent and the rejection should be withdrawn.

The Examiner has rejected claim 11 as unpatentable over Neova in view of the '771 patent and further in view of Cabot. Applicants respectfully traverse this rejection since, for the reasons discussed above, the combination of Neova and the '771 patent fails to render obvious a composition for forming a cosmetic mask comprising at least one colorant and from about 5 to about 40 percent silica, wherein when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color change in the composition when the composition dries. Clearly Cabot fails to remedy the deficiencies of the Neova product label and the '771 patent.

Cabot teaches the inclusion of fumed silica in cosmetic and personal care products. However, there is no teaching or suggestion that fumed silica could be used in combination with a colorant to provide an indication that the composition has dried via a color change in the composition. Accordingly, the combination of Neova, the '771 patent and Cabot fails to render claim 11 obvious and the rejection should be withdrawn.

The Examiner has rejected claims 1-4 and 11-13 as being unpatentable over the '782 patent. Applicants respectfully traverse this rejection.

The '782 patent relates to a composition for the cosmetic treatment of human skin to remove retention products from the skin surface and sebaceous follicles. The composition comprises a high-silica zeolite. The '782 patent teaches that "while colorants may be aesthetically desirable, in certain instances, the normal off-white color of the composition in the absence of added colorants is entirely acceptable as is." See col. 5, lines 30-34. There is no teaching or suggestion that a high-silica zeolite could be used in combination with a colorant to provide an indication that the composition has dried via a color change in the composition. The Examiner recognizes that the '782 patent "does not explicitly provide that the color changes as the composition dries" but nevertheless argues that the color change is "an obvious property" of the composition. Applicants respectfully disagree.

As discussed above, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. The Examiner must provide a rational or evidence which tends to show inherency. See M.P.E.P. § 2112, p. 2100-51. The '782 patent teaches that colorants may be added for aesthetic reasons, there is no teaching or suggestion that the high-silica zeolite could be used in combination with a colorant to provide a composition that

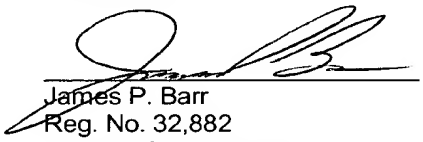
indicates when it is dried via a color change in the composition. Such a characteristic does not necessarily flow from the teachings of the '782 patent. Accordingly, the '782 patent fails to render Applicants' claimed invention obvious and the rejection should be withdrawn.

Applicants respectfully submit that the combination of the references does not provide the present invention. Applicants respectfully submit that the rejections under 35 U.S.C. 103 (a) have been overcome and therefore respectfully request withdrawal of the rejections under 35 U.S.C. 103 (a).

Conclusion

Applicants believe that the foregoing presents a full and complete response to the present Office Action. Applicants believe that this Amendment places the case in condition for allowance, therefore Applicants respectfully request passage of the Claims to allowance.

Respectfully submitted,



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